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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/050,249	03/30/1998	HARUKI OKAMURA	OKAMURA=2B	6601
1444	7590	06/16/2005	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			JIANG, DONG	
			ART UNIT	PAPER NUMBER
			1646	

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/050,249

Applicant(s)

OKAMURA ET AL

Examiner

Dong Jiang

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 8 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 93 and 95-120.

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☒ Other: It is noted that a Notice of Appeal was received on 4/29/05.

ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Continuation of 5. Applicant's reply has overcome the following rejection(s): the new matter rejection of claims 93-96, 98-117 and 119 under 35 U.S.C. 112, first paragraph; the rejections of claim 94 as applicants have canceled the claim; the rejection of 98-117 and 119 under 35 U.S.C. 112, second paragraph, as applicants have canceled the independent claim 94.

Continuation of 11. does NOT place the application in condition for allowance because: The rejection of claims 93, 95, 96 and 98-118 under 35 U.S.C. 112, first paragraph, for lacking adequate written description would be maintained for the reasons of record set forth in the previous Office Actions. Applicants argue, on page 12 of the response filed on 29 March 2005, that claim 93, as amended, obviates the rejection. Applicants argument has been fully considered, but is not deemed persuasive because the amended claim 93 still recites, in part (ii), "homologue thereof ..., in which one or more amino acids are replaced ...", which, as addressed in the previous Office Actions, reads on functional equivalent and IL-18 of other species not disclosed or discovered. The broad genus claim is represented by one molecular species described with particularity in the instant disclosure, and no other species meeting the limitations of the claim is identified or particularly described. With the exception of SEQ ID NO: 2, the skilled artisan cannot envision the detailed chemical structure of the encompassed "homologue thereof", and therefore conception is not achieved.

The prior art rejection of claims 93 and 95-120 under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al. (Infect. Immun. 61: 64-70, 1993), would be maintained for the reasons set forth in the previous Office Actions.

Applicants argue, on pages 12-15 of the response filed on 29 March 2005, that it is mere hindsight that Nakamura's factor in the serum (75 kDa) was the same as IGIF found in the liver extract (19 kDa); that the higher molecular weight form was considered to be bound to another protein or to exist in an oligomeric form, as Nakamura's first publication never states such, and Nakamura's later publication was not published until after the present application was filed; that relying on Nakamura's later publication when considering the obviousness of the invention is unreasonable; and that Nakamura has not succeeded in obtaining a monoclonal antibody to IGIF. Applicants argument has been fully considered, but is not deemed persuasive because such an issue has been addressed in detail in the previous Office Actions, and the relevant part has been reiterated in the Office Action mailed on 7/3/01 (paper No. 22), on page 7. Briefly, "because Nakamura describes the protein of original claim 1, including its biological activity, a monoclonal antibody specific for that protein is obvious under 35 U.S.C. 103 as a matter of law, per counsel's express concession. To the extent that Nakamura is ambiguous as to the molecular weight and to the extent that claim 1 cannot be fairly construed to read on a material which is said to exhibit a molecular weight outside the recited range, counsel's concession nonetheless weighs in favor of the conclusion that the genus of monoclonal antibodies 'specific for the Nakamura IGIF material is obvious under 103. In addition to conceding the obviousness of a mAb to "the protein of claim 1," counsel stated in the reply of 14 February 1997 that "[t]echniques of raising monoclonal antibodies are well known" and that "[k]nowing the biological activity of such protein (as the protein of claim 1) , one of ordinary skill in the art would have been motivated to make a monoclonal antibody for the purpose of immunoaffinity chromatography or for the purpose of blocking its activity. The techniques for doing so are well known." These concessions are generic in nature."